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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/767,046	01/22/2001	Francesco Cocola	70012	4570

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SCARBOROUGH STATION
SCARBOROUGH, NY 10510

EXAMINER

HANDY, DWAYNE K

ART UNIT	PAPER NUMBER
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1743

DATE MAILED: 04/01/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/767,046

Applicant(s)
Cocola et al.

Examiner
Dwayne K. Handy

Art Unit
1743



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-9, 12-15, and 19-26 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2-9, 12-15, and 19-26 is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☒ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09/194,090.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other:

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DETAILED ACTION

Priority

1. Applicant is reminded that in order for a patent issuing on the instant application to obtain the benefit of priority based on priority papers filed in parent Application No. 09/194,090 under 35 U.S.C. 119(a)-(d) or (f), a claim for such foreign priority must be made in this application. In making such claim, applicant may simply identify the application containing the priority papers.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 24 and 26 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 24 and 26 recite an optical detection means and indicia reading means. The specification, however, does not disclose any of the elements one of ordinary skill in the art would need for these two elements.

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4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 6, 21, and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 6, 21 and 22 each contain phrases that limit some structure of the tube by having said structure be "parallel to the detection rays". Since the device is drawn to test tube and not a detection system, this limitation is unclear and indefinite. The Examiner is unclear as to how to form a wall that would be parallel to detection rays when one does not know where the rays will be or what direction they will be traveling.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 19-23, 2-9 and 12-15 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 and 9-20 of U.S. Patent No. 6,190,615. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims are broader than the patented claims. The independent claim of both the instant claims (cl. 19) and the patented claims (cl.1) contain an “indicia wall *being receivable* of optically readable information.” The patented claims recite an “indicia wall *having* optically readable information.” Note: The Examiner listed the claims of the application in the specific order above to show the corresponding patented claim in writing the rejection.

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Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 2, 5, 6, 12, 13, 19-23 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Engelhardt (3,680,967). Engelhardt teaches a liquid sample receptacle with an integral label portion carrying machine-readable indicia identifying the sample source and located substantially parallel to the longitudinal axis of a cup portion. The sample receptacle is structured with respect to the turntable unit to properly align the machine-readable indicia for automatic readout (Abstract). The receptacle is best shown in Figures 1A-1C and described in column 3. The sample receptacle (1) include an elongated cylindrical cup portion (3), formed of plastic or other inert material, having an inverted conical bottom (5) raised slightly above lower extremity. A connector portion (9) is attached to and collars cup portion (3) slightly below its upper extremity (11). Also, connector portion (9) is joined along its wider curved edge (15) to label portion (17). Label portion (17) is slightly curved and the outer surface supports coded indicia identifying the source individual from whom a contained sample was taken. Figure 2 shows the information being read from the receptacle.

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Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Grimm et al. (6,245,570) teaches a container for the irradiation of blood products. The container has a main section for holding blood and an integral flap for identifying indicia. Ridgeway et al. (5,879,628) and Liu et al. (6,388,750) show an apparatus for examining blood samples with optical analysis. Ricci et al. (6,387,327) recites an apparatus for sedimentation tests that uses the tubes of the instant invention. Mathus et al. (6,372,293), Williams et al. (6,350,412), and Riekkinen (6,085,603) display further examples of tubes with identifying information attached to them. Bergmann (3,627,432), Schildknecht (4,659,550), and Koch (5,571,479) show cuvettes.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dwayne K. Handy whose telephone number is (703)-305-0211. The examiner can normally be reached on Monday-Friday from 8:00 to 4:30.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden, can be reached on (703)-308-4037. The fax phone number for the organization where this application or proceeding is assigned is (703)-772-9310.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-0661.


Jill Warden
Supervisory Patent Examiner
Technology Center 1700

dkh

March 24, 2003